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**DEC 14 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Mark Czekaj, Scott I. Klein,	:	
and Heinz W. Pauls	:	
Application No. 10/686,871	:	DECISION ON TWO PETITIONS
Filing Date: October 16, 2003	:	UNDER 37 C.F.R. §§ 1.47(A)
Attorney Docket Number:	:	AND 1.183
DEAV1999S005USCIP	:	
Title: N-ACYLPYRROLIDIN-2-	:	
YLALKYLBENZAMIDINE DERIVATIVES	:	
AS INHIBITORS OF FACTOR XA	:	

Background

This is a decision on the two petitions concurrently filed on September 5, 2006 pursuant to 37 C.F.R. §§ 1.47(a) and 1.183, requesting the acceptance of a declaration without the signature of one of the joint inventors, and the waiver of the requirement for a new declaration under 37 C.F.R. §1.67(a).

The present application was filed on October 16, 2003, and is a continuation-in-part of Application number 10/143,190. The declaration which was provided on filing was associated with this parent application, and was executed by each of the three joint inventors.

On January 25, 2005, Petitioner submitted a declaration which is associated with the present application and does not list Mr. Klein as an inventor. Petitioner further submitted an explanation that Messrs. Czekaj, Klein, and Pauls invented the subject matter disclosed in the parent application, however Mr.

Klein subsequently left the employ of the assignee and was not involved in the development of the subject matter which comprises the new matter that is disclosed in the present continuation-in-part child application.

On January 31, 2006, a non-final action was mailed, which indicated that a supplemental declaration pursuant to 37 C.F.R. §1.67 would be required, and that the supplemental declaration should be associated with the present application as well as executed by each of the three joint inventors.

### **The petition under 37 C.F.R. §1.183**

The petition fee has been charged to Petitioner's Deposit Account, as authorized in the petition.

In short, Petitioner wishes to have the Office waive the requirement that Mr. Klein sign the supplemental declaration which is associated with the present application.

A discussion follows.

### **Applicable Rules**

37 C.F.R. §1.47(a) sets forth, *in toto*:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

37 C.F.R. §1.63(a)(1) and (2) set forth, *in toto*:

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

- (1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;
- (2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

37 C.F.R. §1.67(a) sets forth, *in toto*:

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

### Analysis

In order to submit a grantable petition under 37 C.F.R. §1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not neither asserted nor established that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

### The existence of an extraordinary situation

The PTO has a well established and well publicized practice by

which practitioners may seek the acceptance of a declaration which has been executed by less than all of the joint inventors listed thereon. Petitioner must submit the filing fee, the fee associated with the late submission of the petition (if not presented with the application on filing), a statement of the last known address of the non-signing inventor; proof that either a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application, or the non-signing inventor cannot be found or reached after diligent effort, and a statement that these efforts were not successful, and; a declaration which complies with 37 C.F.R. §1.63.

It is not clear what is extraordinary about a situation where a joint inventor has left the employ of the assignee, and has refused to execute a supplemental declaration.

The question of whether justice requires the waiver of the rule:

Pursuant to Rule §1.47(a), the application may be made by the other signing inventors on behalf themselves and the non-signing inventor.

As such, an avenue exists by which Petitioner may escape this quandary, and it follows that justice does not require that Rule §1.67(a) be waived. Furthermore, it is noted that with the present petition, Petitioner has included a petition under 37 C.F.R. §1.47(a).

### Conclusion

The petition under 37 C.F.R. §1.183 is **DISMISSED**.

### **The petition under 37 C.F.R. §1.47(a):**

With the petition pursuant to Rule §1.47(a)<sup>1</sup>, Petitioner has asserted that the non-signing inventor orally refused to sign the supplemental declaration.

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<sup>1</sup> A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130, if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(f);
- (3) a statement of the last known address of the non-signing inventors;

Both the petition fee and the surcharge associated with the late submission of the present petition have been charged to Petitioner's Deposit Account, as authorized in the petition.

With the present petition, Petitioner has submitted a declaration which complies with 37 C.F.R. §1.63.

As such, requirements (1), (2), and (5) of Rule §1.47(a) have been met.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor<sup>2</sup>.

Regarding the fourth requirement, it does not appear that a complete copy of the present application was sent to the non-signing inventor. It follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign a declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers associated with the present application before a petition under Rule §1.47(a) is granted, since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed<sup>3</sup>.

### Conclusion

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a)

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(4) proof that either:

- a) a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application, or
- b) the non-signing inventor cannot be found or reached after diligent effort, and a statement that these efforts were not successful;

(5) a declaration which complies with 37 CFR §1.63.

<sup>2</sup> See MPEP 409.03(e).

<sup>3</sup> In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§1.47(a) and/or 1.183." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition(s) should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail<sup>4</sup>, hand-delivery<sup>5</sup>, or facsimile<sup>6</sup>.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>7</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office

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4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).